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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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11

DATE MAILED:

This is a communication from the examiner in charge of your application  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 2/28/97

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-14 + 16-18 is/are pending in the application

Of the above, claim(s) 17 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 13-14, 16 + 18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received

☐ received in Application No. (Series Code Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received \_\_\_\_\_

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Applicants election of the following species is acknowledged:

L-Pro-L-boroPro

Pursuant to the election of species, and the §102(e) rejection as set forth hereinbelow, claim 17 is withdrawn from consideration.

◆ ◆

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. §112, first paragraph, for failing to provide an enabling disclosure.

Applicants have alleged that "[w]ith A3.5, Ala-boroPro suppresses HIV below detectable levels in a manner similar to the anti-HIV effect of AST at 1  $\mu$ M". Applicants have also stated (p. 20) that Ala-boroPro and Pro-boroPro inhibit DP-IV *in vitro*. There is, however, no basis for applicants' proposition that for peptides in which "m" is greater than 0, enzyme inhibition will

they will recognize; the departures from tested embodiments which applicants are proposing could well abolish activity. Undue experimentation would be required of the skilled biochemist to determine which of the claimed peptides will inhibit DP-IV.

Claims 13-16 are rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in the objection to the specification.

◆ ◆

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371 of this title before the invention thereof by the applicant for the patent.

Claims 13-15, 16 and 18 are rejected under 35 U.S.C. §102(e) as being anticipated by Bachovchin (USP 4,935,493).

Bachovchin teaches the following dipeptide:

Pro-boroPro.

(See the formula in col 1, line 50+; also "X" can be prolyl as

Serial No. 459,654  
Art Unit 1811

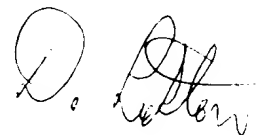
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No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**DAVID LUKTON  
PATENT EXAMINER  
GROUP 1820**